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From the  
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:

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## PCT

WRITTEN OPINION  
(PCT Rule 66)

Date of mailing (day/month/year)	22.09.2004
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Applicant's or agent's file reference  
L0532.70027 *WOOO*

REPLY DUE	within 2 month(s) from the above date of mailing
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International application No.  
PCT/US 03/31877

International filing date (day/month/year)  
08.10.2003

Priority date (day/month/year)  
18.10.2002

International Patent Classification (IPC) or both national classification and IPC  
G06K7/12

Applicant  
VERIFICATION TECHNOLOGIES, INC. et al.

Confirmation <input type="checkbox"/>	Initials
Docketing <input type="checkbox"/>	<i>[Signature]</i>

11/22/04 (E)  
21/10/05 - afe

1. This written opinion is the **first** drawn up by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:
  - I ☒ Basis of the opinion
  - II ☐ Priority
  - III ☒ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
  - IV ☐ Lack of unity of invention
  - V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
  - VI ☐ Certain documents cited
  - VII ☐ Certain defects in the international application
  - VIII ☐ Certain observations on the international application

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3. The applicant is hereby **invited to reply** to this opinion.

**When?** See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension, see Rule 66.2(d).

**How?** By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

**Also:** For an additional opportunity to submit amendments, see Rule 66.4.  
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.  
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 18.02.2005 ✓

Name and mailing address of the international preliminary examining authority:



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**I. Basis of the opinion**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed"*):

**Description, Pages**

1-31 as originally filed

**Claims, Numbers**

1-48 as originally filed

**Drawings, Sheets**

1/6-6/6 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
- ☐ the claims, Nos.:
- ☐ the drawings, sheets:

5. ☐ This opinion has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

6. Additional observations, if necessary:

**III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non-obvious), or to be industrially applicable have not been and will not be examined in respect of:

☐ the entire international application,

☒ claims Nos. 34

because:

☒ the said international application, or the said claims Nos. 34 relate to the following subject matter which does not require an international preliminary examination (specify):

**see separate sheet**

☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. are so unclear that no meaningful opinion could be formed (*specify*):

☐ the claims, or said claims Nos. are so inadequately supported by the description that no meaningful opinion could be formed.

☐ no international search report has been established for the said claims Nos.

2. A written opinion cannot be drawn due to the failure of the nucleotide and/or amino acid sequence listing to comply with the Standard provided for in Annex C of the Administrative Instructions:

☐ the written form has not been furnished or does not comply with the Standard.

☐ the computer readable form has not been furnished or does not comply with the Standard.

**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

1. Statement

Novelty (N)	Claims	1-20,22,24-27,29,31-33,35-45
Inventive step (IS)	Claims	21,23,28,30,46-48
Industrial applicability (IA)	Claims	34

2. Citations and explanations

**see separate sheet**

**Re Item III**

**Non-establishment of opinion with regard to novelty, inventive step and industrial applicability**

**Claim 34** relates to subject-matter considered by this Authority to be covered by the provisions of Rule 67.1(iii) PCT, i.e. methods of doing business. Consequently, no opinion will be formulated with respect to the industrial applicability of the subject-matter of these claims (Article 34(4)(a)(I) PCT).

**Re Item V**

**Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

Reference is made to the following documents:

- D1: WO 01/06453 A (VERIFICATION TECHNOLOGIES INC) 25 January 2001 (2001-01-25)  
D2: US-B-6 203 0691 (LOOP ROBERT ET AL) 20 March 2001 (2001-03-20)  
D3: US-A-5 574 790 (SILVERGLATE DAVID ET AL) 12 November 1996 (1996-11-12)

1. The present application does not meet the criteria of Article 33(1) PCT, because the subject-matter of **independent claims 1 and 31 is not new** in the sense of Article 33(2) PCT.
- 1.2 **Claim 1:** The document D1 discloses (the references in parentheses applying to this document):  
A system for applying at least a portion of an authentication mark to a substrate and verifying the application of at least a portion of the mark on the substrate, the substrate being disposed on a production line (Page 35, lines 9-13), the system comprising:  
- an applicator (ink jet printer: page 35, line 9-10) locatable at the production line and configured and arranged to apply at least one light-sensitive compound (Page 23, lines 5-8) on the substrate to produce at least a portion of the authentication mark (identifying mark: page 35, line 10); and  
- a verification device (Page 35, line 12-13) locatable at the production line and configured and arranged to verify application of the at least one light-sensitive compound on the substrate.
- 1.3 The same reasoning applies, mutatis mutandis, to the subject-matter of the corresponding **independent claim 31**, which therefore is also considered not new.

11/14  
has been cited  
in U.S. case  
PAC

- 2.1 **Dependent claims 2-14, 16-30, 32, 33, 35-48** do not contain any features which, in combination with the features of any claim to which they refer, meet the requirements of the PCT in respect of novelty and/or inventive step, see documents D1, D2 and D3 and the corresponding passages cited in the search report.
- 2.2 With respect to **claim 21 and 23**, a controller communicating with the verification device and applicator or production line controller is not explicitly mentioned in D1. Yet, such a controller is merely obvious in order to take action upon the results of the verification device.
- 2.3 With respect to **claim 24, 28 and 30** reference is made to the passage in D1 on page 27, lines 10-20, where receptacles, adapted to interchangeably receive light sources, source (excitation) or emission filters are mentioned. To adapt these receptacles to receive excitation or emission lenses as in claim 28 or 30, is a straight forward design change.
- 3.1 The application does not meet the requirements of Article 6 PCT, because **claim 15** is not clear.
- 3.2 Claim 15 seeks to define a relationship to another entity, the substrate, which is not part of the system itself. In fact, the substrate undergoes the application and verification by the system.
- 3.3 Furthermore, the above-mentioned lack of clarity notwithstanding, claim 15 is not new in the sense of Article 33(2) PCT, when D1 is considered.